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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,988	02/12/2002	Chris E. Rowen	LEGAP002	3521
57255 7590 02/27/2009 VAN PELT, YI & JAMES LLP AND EMC CORPORATION 10050 N. FOOTHILL BLVD. SUITE 200 CUPERTINO, CA 95014				
			EXAMINER CHANKONG, DOHIM	
			ART UNIT 2452	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/072,988

Applicant(s)

ROWEN, CHRIS E.

Examiner

DOHM CHANKONG

Art Unit

2452

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/28/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 15, 17-20 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 15, 17-20 and 37-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Applicant's amendment, filed on 11/21/2008. Claims 1, 15, and 37 are amended. Claims 5, 6, 8-14, 16, 21-36, and 42-44 were previously cancelled. Accordingly, claims 1-4, 7, 15, 17-20, and 37-41 are presented for further examination.
2. This action is a final rejection.

Response to Arguments

3. Applicant amends the independent claims to recite computing a message tag from a subset of message properties including a sender and message submission time *but not including an entire body of the message*. Applicant's arguments with respect to this amendment have been carefully but are not persuasive for two reasons. First, the amendment is new matter that is not supported by Applicant's specification as detailed in the following §112 rejection. Second, Hughes teaches the limitation. The citation to which Applicant refers does teach including the message body into the hashing function. However, Hughes teaches another embodiment where the message body is hashed to form a separate body message ID and the other message properties are hashed to form a second ID [column 8 «lines 19-25»]. Hughes' second ID reads on Applicant's amended message tag as it excludes the message body from the second ID's hashing function.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4, 7, 15, 17-20, and 37-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 15, and 37 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is reminded that any negative limitation or exclusionary proviso must have basis in the original disclosure. *MPEP §2173.05(i)*. The mere absence of a positive recitation is not basis for an exclusion. *Id.* Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. *Id.*

Here, the amended independent claims recite, *inter alia*, computing a message tag from a subset of message properties including a sender and message submission time *but not including an entire body of the message*. This negative limitation does not have basis in the Applicant's specification. Applicant's specification does not describe excluding the message body from the computation of the message tag. The fact that the specification is silent as to whether the message body is included in the computation at all is not basis for excluding it from the limitation. Because the claims contain a negative limitation that does not have a basis in the specification, they fail to comply with the written description requirement.

Applicant's specification does recite "using the submission time and the sender's name *is usually sufficient* to uniquely identify an email message" (emphasis added) [US 20020122543, 0028]. This disclosure would support a limitation that limited the computation message tag to

only the submission time and the sender; that is, a limitation that excluded *everything but* the submission time and the sender instead excluding just the message body. However, the as the limitation is currently written to exclude only the message body, it is not sufficiently supported by the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7, 15, 20, 37, and 41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, U.S. Patent No. 6,122,372, in view of Yeager, U.S. Patent No. 6,167,402.
6. Hughes was cited in the PTO-892 filed on 10.17.200. Yeager was cited in the PTO-892 filed on 12.22.2005.
7. As to claim 1, Hughes discloses a method for identifying a unique electronic mail message in a plurality of electronic mail messages extracted from an electronic mail messaging system, the method comprising:

computing a message tag from a subset of the plurality of message properties, including a message sender and a message submission time [column 10 «lines 30-35» | column 11 «lines 16-20» | Figure 2 where : Hughes hashes a “message set” where the message set includes the “current time” and sender ID. Hughes describes the “current time” as “the time that the message was sent by the sender], but not including an entire body of the message [column 8 «lines 19-25»];

reviewing a list of message tags stored in a single shared index file associated with multiple electronic mail recipients wherein the message tags are stored in the single shared index file are computed from respective messages [column 3 «lines 23-30» | column 19 «lines 17-27»]; Hughes implies an index file through his teaching of searching for a match in the database];

determining based upon whether the message tag is found in the single shared index file whether the message is not a duplicate message already stored in a message archive [column 19 «lines 17-27»];

storing the message tag in the single shared index file and storing the message in the message archive if it is determined the message is not a duplicate message [column 19 «lines 37-47»]; and

wherein a copy of the message, if stored in the message archive, is archived for a mandated period of time [column 10 «lines 30-33 and 47-52»: in one embodiment, Hughes “expiration time” refers to “how long messages must be stored” | column 24 «lines 32-47» : “maximum holding time”].

While Hughes does disclose that his invention is compatible with email messages [column 8 «lines 43-45»] where the message includes a plurality of message properties [Figure

2], Hughes does not expressly disclose (1) retrieving from a mailbox on the electronic mail messaging system a copy of the message or (2) that the messages are retrieved from a plurality of mailboxes associated with multiple electronic mail recipients. However, these features of retrieving a copy of a message from a mailbox and retrieving messages from a plurality of mailboxes associated with multiple electronic mail recipients was well known in the art at the time of Applicant's invention.

For example, Yeager teaches these features in an invention directed towards a message store that contains an index file [abstract]. Like Hughes, Yeager discloses hashing email messages in order to prevent storing duplicate copies within a message store [column 10 «lines 5-7»]. As to the features not taught in Hughes, Yeager discloses (1) retrieving from a mailbox on the electronic mail messaging system a copy of the message [column 2 «lines 49-62» : teaching the well known feature of retrieving messages from a user's inbox] and (2) that the messages are retrieved from a plurality of mailboxes associated with multiple electronic mail recipients [column 2 «lines 49-62» | column 7 «lines 7-11»]. Despite not expressly teaching a plurality of mailboxes, this feature is implied by the fact that there are multiple mail recipients. It would have been obvious to one ordinary skill in the art to have reasonably inferred the presence of multiple inboxes (and therefore retrieval from them) when there are multiple recipients.

It would have been obvious to one of ordinary skill in the art to have modified Hughes invention with Yeager's teachings retrieving and storing email messages. One would have been motivated to adapt Hughes message store to be compatible with email systems to increase the store's functionality and usefulness.

8. As to claim 7, Hughes as modified by Yeager discloses the index file is stored in a relationship database system [column 3 «lines 23-30» | column 19 «lines 17-27»].
9. As to claims 15, 37, and 41, they are rejected for at least the same reasons set forth for claim 1.
10. As to claim 20, it is rejected for at least the same reasons set forth for claim 7.
11. Claims 2, 3, 17, 18, 38, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, in view of Yeager, in further view of Cloutier et al, U.S. Patent No. 6.535.586 [“Cloutier”].
12. Cloutier was cited in the PTO-892 filed on 8.17.2005.
13. As to claim 2, while Hughes discloses computing a message tag by using a message’s properties, Hughes does not expressly disclose concatenating at least two properties selected from the plurality of message properties. However, the concept of concatenating message properties to calculate a message tag was well known in the art at the time of Applicant's invention.

For example, Cloutier teaches this feature in an invention directed towards generating unique codes for email messages [abstract]. Specifically, Cloutier discloses concatenating message properties to generate a message tag [column 6 «lines 5-35» : Cloutier discloses

computing a checksum by appending the data from the Date and From header fields of the message]. It would have been obvious to one of ordinary skill in the art to have modified Hughes to include Cloutier's teachings of calculating a checksum from concatenating message properties. One would have been motivated to adapt Hughes in such a manner because Cloutier teaches that such a feature insures the generation of a unique code signature for each message thereby increasing the reliability of Hughes' invention.

14. As to claim 3, Hughes as modified by Yeager and Cloutier discloses the message tag is further computed by applying a hash algorithm to the message tag to form a uniform string wherein the uniform string has a predetermined length [Hughes, column 10 «lines 30-35» | column 11 «lines 16-20» | Figure 2 & Cloutier, column 6 «lines 5-35»].

15. As to claims 17 and 38, they are rejected for at least the same reasons set forth for claim 2.

16. As to claims 18 and 39, they are rejected for at least the same reasons set forth for claim 3.

17. Claims 4, 19, and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, in view of Yeager and Cloutier, in further view of Mattis et al, U.S. Patent No. 6,292,880 ["Mattis"].

18. Mattis was cited in the PTO-892 filed on 6.19.2006.

19. As to claim 4, while Hughes as modified by Yeager and Cloutier teaches hashing message properties, Hughes does not expressly disclose utilizing MD5 as the hash algorithm. However, implementing MD5 as a hash algorithm with respect to messages was well known in the art at the time of Applicant's invention.

Mattis expressly discloses hashing message tags using the MD5 algorithm to form a uniform string [column 9 «lines 48-63»]. It would have been obvious to one of ordinary skill in the art to have implemented Hughes hashing algorithm as an MD5 algorithm. The MD5 hashing algorithm was well known in the art at the time of Hughes invention.

20. As to claims 19 and 40, they are rejected for at least the same reasons set forth for claim 4.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452